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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,889	12/21/2000	Ming-Chih Chang	CEIP0017USA	6259
27765	7590	12/11/2003	EXAMINER	
NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE) P.O. BOX 506 MERRIFIELD, VA 22116			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/740,889

Applicant(s)

CHANG ET AL.

Examiner

Tan Dean Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-5, 6-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-5 are directed to "A method of generating a test plan for a quality control procedure", which is not within one of the classes of invention set forth in § 101.

The "method of generating a test plan for a quality control procedure" comprising the steps of (a) providing a template archive, (b) providing a selection system, and (c) providing a conversion system, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method of generating a test plan for a quality control procedure" comprising the steps of (a)-(c) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (computer/computer automation) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

***Claim Rejections - 35 USC § 112***

3. Claims 6-14 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A computer system is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). A computer system is essential to carry out the practice of the invention and should be included in the claimed.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because the preamble calls for "a method for generating a test plan for a quality control procedure" but there are no steps or limitations with respect to carrying out the "quality control procedure" in the body of the claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over POLLALIS et al. (US patent 5,016,170).

POLLALIS et al discloses a method for generating a test plan or task management for variety of project management such as quality control, cost control, job estimating, etc., whereby the plan having a hierarchical structure comprising: 1<sup>st</sup> top level identifying the test plan, 1<sup>st</sup> intermediate level and 1<sup>st</sup> lower level, whereby the method comprising: (a) providing a template archive (see Fig. 26), the template archive comprising at least a template (152, 154, 156), each template having a hierarchical structure comprising: a 2<sup>nd</sup> top level for identifying the template, a 2<sup>nd</sup> intermediate level for identifying at least a sub-process of the template, and a 2<sup>nd</sup> lower level comprising at least a template item file for each sub-process, each template item file comprising testing steps for performing a test of an item if desired, (b) providing a selection system and (c) providing a conversion system that converts the selected template, sub-process, and template item file into a corresponding test plan (see col. 4, lines 25-60, col. 5, lines 10-40, col. 6, lines 55-68, col. 7, lines 10-25, col. 8, lines 10-25, col. 9, lines 20-25, col. 10, lines 20-68, especially col. 11, lines 15-27, Fig. 26, Figs. 27-29). As for the limitation on the user using the selection system and the conversion system, these are inherently included in the method of POLLALIS et al as disclosed above in order to select a desired test plan by selecting the desired template, sub-process, and template item file. Alternatively, it would have been obvious to select the desired test plan on a

quality control issue because on col. 11, line 25, POLLALIS et al discloses that this test plan can be used for quality control and other control functions.

As for claim 2, POLLALIS et al discloses a tree structure as the hierarchical structure of the test plan (see Fig. 26, Fig. 29). As for the limitations of the conversion system of claims 3-4, these are inherently included in the system of POLLALIS et al to allow the creation of a file for each selected sub-process as shown on Fig. 26 when the desired subject is quality control. As for the limitation of a link in the report file in claim 5, this is taught in col. 4, lines 25-50.

As for claim 6, which deals with the system for carrying out the method step of claim 1, it's rejected for the same reasons set forth in claim 1 since the claims are very similar in scope and structures. As for claim 7 which deals with the storing of the template archive on a computer system, this is taught on col. 4, lines 45-50 or col. 6, lines 55-60. As for claims 8, 9, 10, 11 (which are similar to claims 2, 3, 4, 5, respectively), they are rejected for the same reasons set forth in claims 8, 9-10, 11, respectively. As for the various limitations of a viewing system as required on claims 12-13, these are fairly taught in POLLALIS et al as shown on col. 3, lines 20-30, or in Fig. 25, Fig. 29, wherein a project planner or supervisor can interactively develop and display on a computer terminal graphical presentations of the task or test plan. As for the limitation of a printing system to enable the printing of a test report, this is well known/conventional to obtain copy of the report and/or would have been obvious to a skilled artisan if copy the report is desired.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US Patent 4,902,469 discloses status tree monitoring and display system.

2) US Patent 5,696,693 discloses method for placing logic functions and cells in a logic design using floor planning by analogy. See cols. 1-2, which discloses the various design of hierarchy functions or templates.

3) US 2003/0130973 discloses testing plan using tree structure hierarchy.

4) Article "Resource management ... Multicomputers" discloses the development of various algorithms for different task graph models.

5) Article "Diagnostic .. Manufacturing" discloses expert system diagnostic tools for quality control procedures using decision tree structure/diagram.

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9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

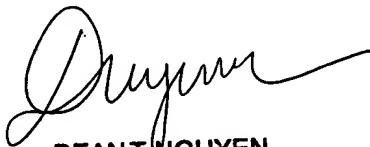
Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
December 3, 2003

  
**DEAN T. NGUYEN**  
**PRIMARY EXAMINER**